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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/528,919	03/23/2005	Thomas E Homeier-Beals	VPL-100-A-PCT-US	9043

7590 11/01/2007
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EXAMINER

ARAQUE JR, GERARDO

ART UNIT	PAPER NUMBER
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3629

MAIL DATE	DELIVERY MODE
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11/01/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/528,919	Applicant(s) HOMEIER-BEALS, THOMAS E	
	Examiner Gerardo Araque Jr.	Art Unit 3629	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 March 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Double Patenting

1. **Claims 1 and 11** of this application conflict with **claims 1 and 11 of Application No. 2007/0021969 A1 (Serial Number 11/188,169)**. 37 CFR 1.78(b) provides that when two or more applications filed by the same applicant contain conflicting claims, elimination of such claims from all but one application may be required in the absence of good and sufficient reason for their retention during pendency in more than one application. Applicant is required to either cancel the conflicting claims from all but one application or maintain a clear line of demarcation between the applications. See MPEP § 822.

Specification

2. The specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

Claim Objections

3. **Claims 5 and 10** are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. Independent claims 1 and 6 already include the limitation "wherein the indicia are representative of a product or service."

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. **Claim 15** is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

6. **Claim 15** recites the limitation "**the indicia**" in **line 1 of claim 15**. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. **Claims 1 – 2 and 4 – 7 and 9 – 10** are rejected under 35 U.S.C. 102(b) as being anticipated by **Flaherty (US PGPub 2003/0115152 A1)**.

9. In regards to **claim 1**, **Flaherty** discloses a system for conducting electronic transactions, comprising:

a wireless communication device having memory storage, a display screen and a microprocessor, said device adapted to receive a transaction program and data (**Page 1 ¶ 13**);

a transaction program stored in said memory storage, said program containing instructions executable by said microprocessor to produce indicia on said display

screen representative of value, where value is selected from the group consisting of an identifier of a purchased good, an identifier of a purchased service, a coupon, a discount, a prepaid transaction, an electronic negotiable instrument, a sum from a credit account, and a sum from a debit account (**Page 1 ¶ 14, 15**);

a scanner in communication with a merchant server for reading said indicia from said device (**Page 1 ¶ 13; Page 2 ¶ 17**); and

a provider server accessible by the merchant server for storing and retrieving user account information (**Page 2 ¶ 31**).

10. In regards to **claims 2, 7, and 15, Flaherty** discloses wherein said scanner reads said indicia from said screen (**Page 2 ¶ 17**).

11. In regards to **claims 4 and 9, Flaherty** discloses wherein said wireless communication device further comprises an antenna for communication with said provider server (**inherently included**).

12. In regards to **claims 5 and 10, Flaherty** discloses wherein said indicia is also representative of a product or service (**Page 1 ¶ 4**).

13. In regards to **claim 6, Flaherty** discloses a wireless communication device for conducting electronic transactions, said device adapted to receive a transaction program and data, comprising:

memory storage for storing a transaction program (**Fig. 8 # 818**);

a display screen (**Fig. 8 #820**);

and a microprocessor for executing instructions contained within said transaction program to produce indicia representative of value, where value is selected from the

group consisting an identifier of a purchased good, an identifier of a purchased service, a coupon, a discount, a prepaid transaction, an electronic negotiable instrument, a sum from a credit account, and a sum from a debit account, said indicia readable by a scanner in communication with a merchant server, where the merchant server is adapted to access a provider server for storing and retrieving user account information **(inherently included)**.

Claim Rejections - 35 USC § 103

14. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

15. **Claims 11 – 13 and 15 – 16** are rejected under 35 U.S.C. 103(a) as being unpatentable over **Flaherty (US PGPub 2003/0115152 A1)**.

16. In regards to **claim 11**, **Flaherty** discloses a method of conducting electronic transactions, said method comprising:

providing a wireless communication device having memory storage, a display screen and a microprocessor, the device being adapted to receive a transaction program and data (**Page 1 ¶ 13**);

selecting a transaction (**Page 1 ¶ 14**);

generating an indicia of value where value is selected from the group consisting of an identifier of a purchased good, an identifier of a purchased service, a coupon, a

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discount, a prepaid transaction, an electronic negotiable instrument, a sum from a credit account, and a sum from a debit account (**Page 1 – 2 ¶ 14 – 16**);

retrieving the indicia of value (**Page 2 ¶ 20**);

providing the indicia of value to a merchant scanner (**Page 1 ¶ 13; Page 2 ¶ 17**);

and

redeeming the indicia of value (**obviously included**).

Flaherty fails to disclose wherein the value is selected all of the variety of identifiers as disclosed above.

However, **Flaherty** discloses various types of coupons, discounts, special-offers, marketing strategies, and etc. are old and well known in the art. **Flaherty** further discloses that customer profiles are also stored within the system. Moreover, the Examiner asserts that one having ordinary skill in the art would have been aware that various type of indicia can be stored and depending on the type of business carried out or offered would affect the type of information to be encoded into the indicia.

Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention in view of the teachings of **Flaherty** that a various types of information can be stored and transmitted between two devices depending on the type of business being practiced and that the above disclosed group are old and well known business practices.

17. In regards to **claim 12**, **Flaherty** discloses wherein the indicia is downloaded from the provider server (**Page 2 ¶ 20**).

18. In regards to **claim 13, Flaherty** discloses wherein the indicia is generated by the wireless communications device (**Page 2 ¶ 19**).

19. In regards to **claim 15, Flaherty** discloses wherein said scanner reads said indicia from said screen and is redeemed (**obviously included; see also Page 2 ¶ 17**).

20. In regards to **claim 16, Flaherty** discloses use of various types of handheld devices as well as the use of creating and storing a user profile (**Page 3 ¶ 35; Page 2 – 3 ¶ 31 – 33**). However, **Flaherty** fails to disclose further comprising the step of entering a password before the step of retrieving the indicia of value.

However, Official Notice is taken that one having ordinary skill in the art would have been known to incorporate a security feature in order to prevent unauthorized access to not only a personal handheld device, but also to a user profile. The Examiner asserts that cellular telephones and PDA's are known to have password protection before access is granted. Further still, the Examiner also asserts that it is old and well known for user profiles to have limited access and that only those individuals who have authorization are allowed to have access to such sensitive information. One of ordinary skill would have been aware of both these features and, as a result, would have known to incorporate these security measurements, which are well known in the art at the time of the invention, in order to avoid any tampering of sensitive information, especially since this information could be used in identity theft.

Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to modify **Flaherty** to include security measures, such as password protection, before initiating a transaction in order to avoid tampering with a

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user's profile, as well as making any purchases that the user would not have made aware of.

21. **Claim 3, 8 and 14** is rejected under 35 U.S.C. 103(a) as being unpatentable over **Flaherty (US PGPub 2003/0115152 A1)** in view of **Hung et al. (US PGPub 2002/0070278 A1)**.

22. In regards to **claims 3, 8 and 14**, **Flaherty** discloses a two-way communication device wherein a barcode is displayed on the screen to be scanned by a sales clerk. However, **Flaherty** fails to specifically disclose wherein the indicia is a two dimensional barcode.

Hung teaches a similar system wherein a variety of different types of barcodes are used. **Hung** discloses that it is old and well known for handheld devices to display a two dimensional barcode that is then scanned by a scanner (**Page 2 ¶ 17**).

Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to modify **Flaherty** in view of the teachings of **Hung** to have the two-way communication device to display a two-dimensional barcode since it is old and well known for retailers to use a variety of different barcodes as a means of encoding information.

Conclusion

23. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure can be found in the PTO-892 Notice of References Cited.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gerardo Araque Jr. whose telephone number is

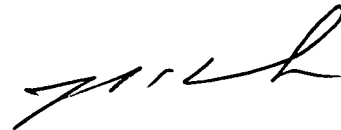
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(571)272-3747. The examiner can normally be reached on Monday - Friday 8:30AM - 4:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (571) 272-6812. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

GA
10/22/07



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